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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/908,852 08/08/97 ROE

D 5494CR

QM12/0620

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EXAMINER

POLUTTA, M

ART UNIT	PAPER NUMBER
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3761

22

DATE MAILED:

06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/908,852

Applicant(s)

Roe et al

Examiner

M. P. 1-26

Group Art Unit

3761

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/10/2000
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 1-26 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ Claim(s) 1-26 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Continued Prosecution Application

1. The request filed on September 13, 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/908,852 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dreier et al. (5,171,236) in view of Buchalter (3,896,807).

Dreier discloses a disposable diaper including a topsheet, a backsheet and an absorbent core wherein the topsheet is made from a hydrophilic material. (7:60-8:10)

Buchalter discloses an oil phase empregnant in the form of a non-oily solid that forms a cream upon the application of perspiration and heat (3:10-12) that is used on articles such as facial mask, slippers, sanitary napkins, diapers and diaper liners

wherein the therapeutic cream is applied to the skin. (3:14-20) Since the empregnant is applied to the article, it inherently has some pattern. The wearer's skin will produce sufficient moisture and heat to cause emulsification of a portion of the oil phase. The substance is dry non-oil non-greasy solid at room temperature (6:13-16) and it is essentially free from water. (6:51-53)

The formulation is made from about 1% to about 99% and preferably from about 30% to about 70% of an oily material which includes mineral oil and petrolatum (3:30-40), and from about 99% to about 1% and preferably from about 30% to about 70% of an immobilizing agent. The resulting preparation can be applied to the article in a liquid phase and cooled to form a solid oil phase (6:38-40).

The oil phase may additionally include, but are not limited to paraffin, vegetable oils, animals oils and isopropyl palmitate (3:35-41). The oil phase is in the form of a dry, nonoily, nonsticky solid at room temperature, and comprises an oily material and one or more emulsifying agents and may include in addition, one or more emollients etc. (2:32-50) It is important that water is not present in the oil phase before emulsification (6:51-53).

The immobilizing agent or emulsifying agent includes cetyl alcohol, long chain fatty acid partial esters of a hexitol anhydride wherein the fatty acid has at least 6, preferably from 12 to 18, carbon atoms including the long chain fatty acid partial esters of sorbitan, sorbide, mannitan and mannide and mixtures thereof (3:42-55),

polyoxylalkyne derivatives and soaps of aliphatic acids (4:9-50) The emulsifying agent appears to be an equivalent to applicants' immobilizing agent.

Dreier discloses an absorbent product including a hydrophilic topsheet.

Buchalter teaches that it is known to apply a skin care product to sanitary napkins and diapers that will emulsify a portion of the oil phase upon moisture and heat. It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply a lotion as taught by Buchalter to a diaper as taught by Dreier to prevent chafing or chapping of the skin since Buchalter's substance is not greasy and oily. The lotion is inherently applied in a predetermined pattern, since it is applied.

It would have been obvious to one having ordinary skill in the art at the time the invention was made as a matter of design choice to apply the lotion such that some portions of the topsheet's outer surface would not be coated, to apply the lotion in stripes wherein the immobilizing agent comprises a polyhydroxy fatty acid ester or a polyhydroxy fatty acid amide having the specific formulas as in claims 24 or 25 or an agent such as paraffin wax, since applicant has not disclosed that the particulars unexpectedly solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well as disclosed by Buchalter and Dreier.

I must conclude that the use a topsheet wherein some outer surface portions are not coated, wherein the lotion is applied in stripes and the immobilizing agent comprises a polyhydroxy fatty acid ester or a polyhydroxy fatty acid amide having the

specific formulas as in claims 24 or 25 and an immobilizing agent such as paraffin wax are merely a matter of engineering design choice, and thus do not serve to patentably distinguish the claimed invention over the prior art. See In re Kuhle, 526 F.2d. 553, 188 USPQ 7 (CCPA 1975).

Applicant is also reminded that arguments toward the criticality of an element will generally be given little patentable weight. The basis for criticality should be disclosed in the specification or supplied by affidavit. See In re Cole, 140 USPQ 230 (CCPA 1964).

Response to Arguments

4. Applicant's arguments filed April 10, 2000 have been fully considered but they are not persuasive.

Applicant argues that the combination of references does not teach applying the lotion in a predetermined pattern, much less in stripes. If the lotion is applied, it is inherently applied in a pattern and the amount, location, distribution of the lotion will also inherently vary some what as articles are made on an assembly line. While applicant argues that the use of intermittent stripes of lotion is critical to the invention, the specification (26:32-36) states that if the lotion is applied nonuniformly, any lotion pattern may be used, such as small droplets or stripes.

Furthermore, the level of skill in the disposable diaper art is quite high. A person of ordinary skill in the art would be typified by an individual with a college degree in engineering or one of the sciences and three to five years work experience in the diaper industry. "This hypothetical individual would understand the basics of diaper design and the characteristics of the available materials". *Procter & Gamble Co. v. Paragon Trade Brands Inc.*, 989 F.Supp 547, 587(D.Del 1997).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. WO 94/09757 cited by applicant discloses a cream and a lotion that can be applied to a diaper. Kassai (4,753,643) discloses a disposable diaper including baby powder disposed along the side edges. Duncan (3,489,148) discloses a topsheet for a disposable diaper treated to alleviate diaper rash including a moisture barrier material applied in a discontinuous film comprising a multiplicity of discrete droplets.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark O. Polutta whose telephone number is (703) 308-2114.

The examiner's supervisor, John Weiss, telephone number is (703) 308-2702. The fax phone number for official papers for this Group is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Mark O. Polutta
June 16, 2000


MARK O. POLUTTA
PRIMARY EXAMINER
SECTOR 3700